

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/895,214 07/02/01 JANG

D 065315

WM02/1017

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EXAMINER

WATKIN, T

ART UNIT

PAPER NUMBER *S*

2652

DATE MAILED:

10/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks*T.R*

| | | |
|------------------------------|------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/895,214 | JANG ET AL. |
| | Examiner Julie Anne Watko | Art Unit 2652 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09/27/2001
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,4-9,11,12 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 6-8,11,12 and 15 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,4,5 and 9 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07/02/2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). 5 . |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The election of species filed September 27, 2001, paper no. 4, includes an election of "Species D, i.e., claims 4 and 5"; however, neither claim 4 nor claim 5 is readable on Species D, drawn to Figs. 12-13. In a telephone conversation between the Examiner and Stan Torgovitsky (Reg. No. 43958), Applicant elected Species C, drawn to Figs. 10-11. An action on the merits follows for claims 1, 4-5 and 9. Claims 6-8, 11-12 and 15 are withdrawn from consideration as drawn to non-elected species.
2. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Priority

3. Applicant is reminded that in order for a patent issuing on the instant application to obtain the benefit of priority based on priority papers filed in parent Application No. 09251402 under 35 U.S.C. 119(a)-(d), a claim for such foreign priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

Drawings

4. Figures 1-2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
5. The drawings are objected to because they do not incorporate the proposed drawing changes filed October 14, 2000, in paper no. 7 of the parent case. Correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 4-5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation “permanent magnets” in line 6. This limitation is misdescriptive of the specification. Figures 10-11 show only one permanent magnet; therefore, it is unclear how many permanent magnets are claimed.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 4-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakazawa et al (US Pat. No. 5448435).

As recited in claim 1, insofar as it is understood in view of the rejection under 35 USC § 112, Nakazawa et al show a magnetic latching apparatus for use in a hard disk drive, in which a magnetic head 3 is automatically positioned at a parking zone SZ of a magnetic disk 1 as an arm 4 returns back at an initial position when an electric current applied to the hard disk drive is interrupted, comprising: a permanent magnet 20 disposed on a predetermined portion at an outer

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end of the arm; and means (including 10) for locking and unlocking the arm by means of a magnetic force of the permanent magnet, the means being mounted to be associated with the permanent magnet to repulse the permanent magnets when the electric current is applied to the hard disk drive and to attract the permanent magnet when the electric current applied to the hard disk drive is interrupted (see col. 7, line 61-col. 8, line 40).

As recited in claim 4, Nakazawa et al show that the permanent magnet 20 has one polarity N at one end thereof and the other polarity S at the other end thereof, of which both ends face with the means for locking and unlocking the arm and of which a portion except for both ends of the permanent magnet is fixed to the arm (see Fig. 3B).

As recited in claim 5, Nakazawa et al show that the means for locking and unlocking the arm includes a core 11 having connectors which respectively are formed at each end thereof (see Fig. 3B) and have the same polarities as these of the permanent magnets when the electric current is applied to the hard disk drive (see col. 8, lines 24-37), a bobbin combined with the core to be in parallel to the permanent magnets, and a coil 12 wound on the core 11.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazawa et al (US Pat. No. 5448435).

Nakazawa et al show a magnetic latching apparatus for use in a hard disk drive as described above for claims 1 and 4-5.

As recited in claim 9, Nakazawa et al show a damping member 23 disposed between a magnet 20 and a part 24 on which the magnet is mounted so as to connect the part to the permanent magnet.

As recited in claim 9, Nakazawa et al do not explicitly show that a damping member is disposed between the outer end of the arm and the permanent magnet so as to connect the arm to the permanent magnet.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to dispose a damping member between the outer end of the arm of Fig. 3a of Nakazawa et al and the permanent magnet so as to connect the arm to the permanent magnet. The rationale is as follows: one of ordinary skill in the art would have been motivated to dispose a damping member between the outer end of the arm and the permanent magnet so as to connect the arm to the permanent magnet in order to buffer a shock of impact, to damp vibrations and to suppress generation of unwanted noise as is notoriously well known in the art.

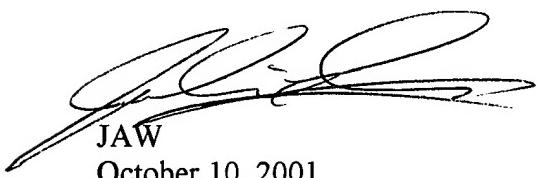
Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sampietro et al (US Pat. No. 5361182) and Campbell et al (US Pat. No. 5452162) each show a magnetic latching apparatus for use in a disk drive.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (703) 305-7742. The examiner can normally be reached on Mon-Thurs 10:30-8 and alternate Fri 9:30-6.

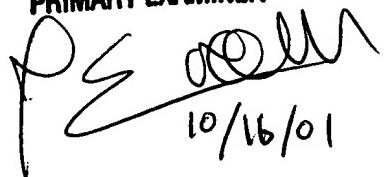
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 305-7201 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



JAW
October 10, 2001

JEFFERSON EVANS
PRIMARY EXAMINER



PG 10/16/01